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09/943,524	08/29/2001	Assaf Henkin	KABAP002	9046

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/943,524

Applicant(s)

HENKIN ET AL.

Examiner

Brian Goddard

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Z</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3, 6-16, 19-42, 45-53 and 56-74 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,141,010 to Hoyle.

Referring to claim 1, Hoyle discloses a method for generating markup information to be displayed on a client computer system as claimed. See Figures 1-14 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches "a method [See Figs. 10-12] for generating markup information [banner advertisements inserted into markup language (e.g. HTML) documents (See Figs. 1-5)] to be displayed on a client computer system [18], the client system including memory [See column 7, lines 14-26] configured to store at least one update file [130 (See Fig. 7)], the at least one update file including keyword information [category identifiers and keywords (See column 16, lines 1-8)] relating to keywords suitable for markup, the method comprising: analyzing [See Fig. 12] selected context ['Key Event' (See Step 178)] associated with a first document [web page] for selected keywords [See above and Column 16,

lines 1-8]], the first document being displayed on the client system to an end user [See Figs. 11-12];

the selected keyword information being provided by an entity other than the end user [See Figs. 7 & 11-12 and Column 16, lines 1-8];

selecting, using the selected keyword information, specific text in the first document to be marked up [a banner advertisement is selected (See Fig. 7 & step 224)];

performing, at the client computer system, markup operations on at least a portion of said selected specific context [Step 224]" as claimed.

Referring to claim 2, Hoyle discloses the method for generating markup information as claimed. See Figures 1-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, wherein said method is performed locally at the client computer system [by the ADM Module (14) Client Software Application (10)] as claimed.

Referring to claim 3, Hoyle discloses the method for generating markup information as claimed. See Figures 1-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, further comprising:

retrieving [Steps 212 & 218] the first document [web page (also 'information resource')] from an initial source [e.g. server];

storing said retrieved first document locally [web page is loaded and stored in browser's cache] at the client system; and

wherein said analyzing [See above] is performed on the stored first document in real-time [See column 6, lines 1-5 and column 16, lines 24-52] at the client system as claimed.

Claims 6-8 are rejected on the same basis as claim 2. See the discussions regarding claims 1-2 above, and the portions of Hoyle's specification cited therein, for the details of this disclosure.

Referring to claim 9, Hoyle discloses the method for generating markup information as claimed. See Figures 13-14 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, further comprising downloading [Step 184] said keyword information [See column 7, lines 52-58; column 8, lines 37-41; & column 12, lines 5-9] from a remote server system [ADM server 22] at periodic intervals as claimed.

Referring to claim 10, Hoyle discloses the method for generating markup information as claimed. See Figures 1-5 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, wherein the markup operations [See above] result in marked up document context which has a visual appearance different than its initial parsed appearance [with the addition of a banner advertisement] as claimed.

Referring to claim 11, Hoyle discloses the method for generating markup information as claimed. See Figures 1-11 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 10, as above, wherein the marked up document context [e.g. banner advertisement] includes a link

[Destination Link (See Fig. 7 & Steps 192-194)] based on information included in the at least one update file [See Fig. 7] as claimed.

Referring to claims 12-13, Hoyle discloses the method for generating markup information as claimed. See Figure 3 and the corresponding portion of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 10, as above, wherein the marked up document context corresponds to keywords selected by [assigned to (See column 8, lines 44-52)] a campaign provider ['advertising distribution organization' 50 (See column 8, lines 44-52)] or an advertiser ['advertisers themselves' 50 (See column 8, lines 44-52)] as claimed.

Referring to claims 14 and 15, Hoyle discloses the method for generating markup information as claimed. See the discussion regarding claim 3 above for the details of this disclosure. Specifically, Hoyle's first document [web page (also 'information resource')] corresponds to a web page or frame in a web page retrieved from an information provider's [e.g. server] web page/site [See also Background & Summary] as claimed.

Referring to claim 16, Hoyle discloses the method for generating markup information as claimed. See Figures 1-5 & 10-11 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, further comprising displaying [See Steps 212 & 218] at least a portion of the first document to the end user via a browser application ['Default Browser'] as claimed.

Referring to claims 19-20, Hoyle discloses the method for generating markup information as claimed. See Figures 1-11 and the corresponding portions of Hoyle's

specification for this disclosure. Hoyle teaches the method of claim 1, as above, wherein the update file includes restriction information [See column 15, lines 1-67] specifying at least one restricted source location ['trigger link']...wherein the restricted source corresponds to a particular Internet domain name [base URL] as claimed.

Referring to claims 21-22, Hoyle discloses the method for generating markup information as claimed. See Figures 1-11 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, wherein the update file includes restriction information [See column 15, lines 54-67] specifying a maximum number of markups per page ['maximum number of permitted displays']...and a maximum number of markups per repeat keyword [max 'frequency' of banner display]...as claimed.

Referring to claim 23, Hoyle discloses the method for generating markup information as claimed. See Figures 7-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, wherein at least one keyword corresponds to a text string [category name or keyword (See Fig. 7)] which includes multiple words [number of keywords] as claimed.

Claims 24-25 are rejected on the same basis as claims 21-22. See the discussions regarding claims 1 and 21-22 above for the details of this disclosure.

Referring to claim 26, Hoyle discloses the method for generating markup information as claimed. See Figures 7 & 11-12 and column 12, line 27 – column 13, line 10 of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, further comprising displaying a pop-up layer [pop-up notes or pop-up new

browser window] on the client system in response to the user selecting a marked up portion of a first portion of document context [Steps 192 & 208];

wherein the pop-up layer includes information relating to an initial link [destination link] associated with the first portion of document context; and

wherein the pop-up layer includes information relating to a different link [new banner advertisements which are displayed based on the invention] which was not associated with the first portion of document context [original document or web page] as claimed.

Claim 27 is rejected on the same basis as claim 26. See the discussion regarding claim 26 above, and the portions of Hoyle's specification cited therein, for the details of this disclosure.

Referring to claim 28, Hoyle discloses the method for generating markup information as claimed. See Figures 7-12 and the corresponding portions of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 1, as above, further comprising:

logging, on the client system [See column 11, lines 53-57 & Fig. 10], tracking information ['computer usage information'];

said tracking information including at least one of the following portions of information:

information relating to impressions, marked up keywords, or keywords clicked by the end user during a specified time interval [See Step 182].



Referring to claim 29, Hoyle discloses the method for generating markup information as claimed. See Figure 10 and the corresponding portion of Hoyle's specification for this disclosure. Hoyle teaches the method of claim 28, as above, further comprising periodically reporting [Step 182] said logged tracking information ['computer usage information'] to a remote server system [ADM Server 22] for analysis and processing as claimed.

Claims 30-31 are rejected on the same basis as claim 29. See the discussions regarding claims 28-29 above, as well as the portions of Hoyle's specification cited therein, for the details of this disclosure.

Claim 32 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure.

Claim 33-36 and 40 are rejected on the same basis as claim 26. See the discussions regarding claims 1 and 26 above, and the portions of Hoyle's specification cited therein, for the details of this disclosure.

Claims 37-39 are rejected on the same basis as claims 6, 14 and 15 respectively, in light of the basis for claim 33 above. See the discussions regarding claims 1, 6, 14, 15, 26 and 33 above for the details of this disclosure.

Claim 41 is rejected on the same basis as claim 1. See the discussion regarding claim 1 above for the details of this disclosure. In particular, Hoyle teaches "a system [See Figs. 1-4] for generating markup information to be displayed on a client computer system [18], the system comprising:

at least one processor [See column 7, lines 1-26];

at least one interface [32] configured or designed to provide a communication link [20] to at least one other network device [22] in a data network; and  
memory [30, 34 (See column 7, lines 1-26)];  
said at least one processor being configured to...[See Claim 1 above]" as claimed.

Claims 42, 45-53 and 56-68 are rejected on the same basis as claims 3, 7, 9-16 and 19-31 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 3, 7, 9-16 and 19-31 above for the details of this disclosure.

Claims 69-74 are rejected on the same basis as claims 33-36 and 38-39 respectively. See the discussions regarding claims 33-36 and 38-39 above for the details of this disclosure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4-5, 17-18, 43-44 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle in view of U.S. Patent No. 6,098,065 to Skillen et al.

Referring to claim 4, Hoyle's analysis does not explicitly include a fuzzy search for selected keywords in the selected text as claimed. However, Hoyle's analysis does include topical/categorical analysis of the selected text to determine if it falls in a specific category. See Figure 7 and the discussion of Step 222 for the details of this disclosure. This provides direct suggestion for using fuzzy search techniques to find inexact matches of keywords in the selected text, in order to categorize the selected text without necessity of an exact match (which is highly unlikely).

Skillen discloses a system and method similar to that of Hoyle, in which fuzzy search techniques are performed [See column 4, lines 14-25 and column 5, lines 29-38] for selected keywords ['search argument'] in the selected text, the fuzzy search being implemented such that a match will be found to occur despite lack of an exact match [non-precise matching] of the selected keywords within the context of the first document [e.g. web page] as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Skillen's fuzzy search logic to Hoyle's system so as to provide Hoyle with fuzzy search capability in searching for the keyword(s) or categories

for displaying the advertising. One would have been motivated to do so because of the direct suggestion provided by Hoyle, as described above.

Referring to claim 5, the system and method of Hoyle in view of Skillen as applied to claim 4 above discloses the invention as claimed. See column 6, lines 20-44 of Skillen's specification for this disclosure. Skillen's fuzzy search, as applied to Hoyle's system above, is implemented such that a match will be found to occur if a percentage of the selected keywords ['search argument(s)'] identified in the context of the first document exceeds a predetermined match threshold percentage value [See column 6, lines 20-44] as claimed.

Referring to claims 17 and 18, the system and method of Hoyle in view of Skillen as applied to claim 4 above discloses the invention as claimed. See the Background & Summary of Skillen's specification for this disclosure. Skillen's fuzzy search logic, as applied to Hoyle's system above, uses negative word filtering [using fuzzy search for keywords in conjunction with the 'NOT' operator] to exclude markups of selected document text [See above] as claimed.

Claims 43-44 are rejected on the same basis as claims 4-5 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 4-5 and 41 above for the details of this disclosure.

Claims 54-55 are rejected on the same basis as claims 17-18 respectively, in light of the basis for claim 41 above. See the discussions regarding claims 1, 17-18 and 41 above for the details of this disclosure.

**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application Publication No. 2002/0052925 to Kim et al. and U.S. patent No. 5,995,943 to Bull et al. are each considered particularly pertinent to applicants' claimed invention. The remaining prior art of record is considered pertinent to applicants' disclosure, and/or portions of applicants' claimed invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg  
20 August 2004

  
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